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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,055	07/14/2006	Emilio Morini	2541-1050	2441

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YOUNG & THOMPSON
209 Madison Street
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Alexandria, VA 22314

EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3781

NOTIFICATION DATE	DELIVERY MODE
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10/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/586,055	Applicant(s) MORINI, EMILIO	
	Examiner JAMES N. SMALLEY	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/14/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, from which the remaining claims depend, uses the term "inferiorly" in line 3. It is not clear what the meaning of the term is. Examiner notes the security strip (12) is connected to a lower end of the lower part (4).

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Likewise, claim 7 limits a cutting element "superiorly" projecting from the lower part. This limitation is indefinite for two reasons: a) it is not clear what the term "superiorly" comprises; b) the cutting element (9) is not connected to the lower part (4) and projects into the bottle. It is not clear how it "projects" from the lower part (4).

Regarding claim 8, it is not clear what the metes and bounds of the phrase "in a shape corresponding to a human fingertip" comprise. In other words, it is not positively claimed that the indentation is shaped like a fingertip, only that it "corresponds" to such shape. This is not a positive recitation. Broadly interpreted, the phrase could be construed as "a shape which is intended for a human fingertip" which is the interpretation Examiner gives for the purposes of this examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowes et al. US 3,156,369 in view of Morini US 6,148,996 and in view of Bernhardt '833.

Examiner notes the terms "means for connecting" and "means for coupling" are not a proper means-plus-function limitations, as described in MPEP 2181, because they are modified by sufficient structure for achieving the specified function within the independent claim in which they are introduced.

Bowes '369 teaches a capsule comprising a lower part (18), a means for connection for removable insertion on a neck (17, 19), a reservoir (15), a breakable bottom (16), a cutting element (34), an upper part (33).

The reference teaches all limitations substantially as claimed, except for a guarantee ring, and easy break ribbing.

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Regarding the guarantee ring, one of ordinary skill in the art would recognize that it would not be wise to manufacture the closure without some form of tamper prevention, to prevent unscrewing of the cap off the container.

Morini '996 teaches a guarantee ring for a threaded closure, and states in col. 3, lines 57-60 that the guarantee ring "prevent[s] axial raising movements of the cap."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Bowes '369, providing a guarantee ring as taught by Morini '996, motivated by the benefit of providing tamper evidencing. The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (*Id.*); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*). In *KSR*, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at ___, 82 USPQ2d at 1395.

Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (A), it is obvious to combine known elements in a predictable manner.

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Regarding the easy-break ribbing, the reference instead teaches a groove (32a) which is a functional equivalent to easy-break ribbing.

Bernhardt '833 teaches a removable section (A) of a container cover, and teaches in col. 4 line 7 that the breakable section can be a "perforation or score line." A perforation is well known in the art to be composed of a series of through-cuts, which inherently create frangible bridges/easy-break ribbing.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cover of Bowes '369, providing a perforation in place of the score line, as taught to be an equivalent for a removable section of a container cover by Bernhardt '833, motivated by the benefit of providing a visible indication of the breaking location.

Regarding claim 7, the cutting element (34) is located on the bottom of the capsule, and is held internally of the upper part as shown in figure 1.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowes et al. US 3,156,369 in view of Morini US 6,148,996 and in view of Bernhardt '833 as applied above to claim 6, and further in view of Smith et al. US 2003/0034323.

Bowes '369, as modified above, teaches all limitations substantially as claimed, but fails to teach an recess in the top part and the bottom part, which form an indentation.

Smith '487 teaches a closure within a closure, which is pivoted in order to fracture a tamper evident means, and gain access to the container contents, whereby a top part (40) has a recess (126) and a bottom part (30) having a recess (52, 54, 56, 58) which combine to form an indentation. The limitation "corresponding to a human fingertip" is not read such that the shape is that of a fingertip; only that it is intended to be used by a fingertip.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Bowes '369, providing the pivoted cap and indentations taught by Smith '487, motivated by the benefit of providing means to access the plunger without having to pass the finger through a narrow opening which may potentially have sharp edges.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/
Supervisory Patent Examiner, Art Unit
3781

/James N Smalley/
Examiner, Art Unit 3781